

REMARKS

This paper is submitted in response to the Final Office Action dated October 18, 2007. Claims 1, 5, 9, 10 have been amended. Claims 11 and 12 have been added. Claims 1-12 remain in the application. In view of the foregoing amendments, as well as the following remarks, Applicants respectfully submit that this application is in complete condition for allowance and request reconsideration of the application in this regard.

Claims 1-10 stand rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,885,299 to Winslow et al. ("Winslow"). Claims 1, 9, and 10 are the only independent claims of this group. Claims 1 and 10 have been amended to recite that the inner cannula includes threads configured to threadably engage a portion of the spinal implant. Similarly, claim 9 has been amended to recite that the inner cannula includes threads on an interior surface thereof.

Winslow fails to teach the structure recited in either of amended claims 1, 9, and 10. More particularly, Winslow fails to teach either an inner cannula including threads configured to threadably engage a portion of the spinal implant or an inner cannula including threads on an interior surface thereof. The Office Action asserts that:

Winslow et al. discloses a spinal surgical instrument (100) comprising: an outer cannula (110) having a proximal end, distal end and an outer lumen passing there between (see Figure 2 below), the distal end of the outer cannula configured to releasably mount to a securing arrangement for a spinal implant; an inner cannula (118) having a proximal end and a threads (144) configured to threadably engage a portion of the spinal implant

(see Fig. 10A), a distal end and an inner lumen passing there between (see Figure 2 below), the inner cannula (118) being axially moveable within the outer lumen of the outer cannula (col. 4, lines 27-39); a fixing member (132) having a proximal end and a distal end (see Figure 2 below), the fixing member (132) positioned within the inner lumen and including an arrangement (col. 4, lines 50-58). The inner cannula (118) is axially moveable within the outer lumen of the outer cannula (110; col. 4, lines 27-31). The engagement structure (114) at the distal end of the outer cannula (110) is configured to releasably engage a locking nut. It is noted that the distal end of the cannula is capable of being configured to releasably engage a locking nut if one so desires to do so. The outer cannula (110) includes an exterior surface contour to facilitate gripping of the outer cannula (110; see Figure 1 below).

(Office Action at p. 2-3).

In response to arguments presented by Applicants in a response filed

August 9, 2007, the Office Action asserts:

Applicant argues that Winslow fails to teach threads of the inner lumen for threadably engaging a portion of the spinal implant. This is displayed with the threads (142) in the inner lumen disposed on implant engaging structure (144) that is considered to be a part of the inner lumen.

(Office Action at p. 4-5)

Applicants understand the Office Action to assert that the threads recited in claim 1 are allegedly the threads (142) that are disposed on the asserted implant engaging structure (144) of the device in Winslow, which forms part of the asserted fixing member (132). The Office Action admits that the asserted fixing member (132) is positioned within the inner lumen of the inner cannula (118). Accordingly, Applicants assert that the threads (144) cannot be part of the inner cannula recited in claim 1. To

the contrary, since the asserted threads are disposed on the implant engaging structure (144) (and thus on the fixing member 132) they must necessarily be part of another structure other than the inner cannula (118), such that the inner cannula (118) may be, in accordance with assertion in the Office Action, positioned within the lumen of the inner cannula (118).

Applicants understand that the Winslow reference is interpreted as having threads within the inner lumen and therefore readable on the rejected claims. The term “lumen” can be defined as “the canal, duct, or cavity of a tubular organ”. (Dictionary.com Cambridge v. 1.1). As such, any structure contained within or surrounded by the lumen or cavity may be considered to be included in the inner lumen, such as the threads 142 on the structure 144 of Winslow according to the interpretation applied in the Office Action.

Without conceding or endorsing that interpretation, Applicants have amended the claims herein to recite that the threads are on the inner cannula as opposed to within the inner lumen. “Cannula” can be defined as “a small tube for insertion into a body cavity, duct, or vessel”. (Merriam-Webster’s Medical Dictionary 2002.) One difference is the cavity or space (lumen) versus the tubular structural member (cannula). Winslow does not disclose threads on the inner cannula structure as now claimed in claims 1-12.

Moreover, the asserted inner cannula (118) does not have threads on an interior surface thereof or any other surface thereof, as best appreciated in FIGS. 2 and 8A of Winslow. As discussed above, the asserted threads (142) are, rather, disposed on the implant engaging structure (144), which does not form part of the asserted inner cannula (118).

Notably, the device recited in claim 1 of the application, by having an inner cannula that includes threads, can carry out specific functions that devices disclosed in the cited prior art cannot carry out. By way of example, and without limitation, when the threads recited in claim 1 take the form of exemplary threads (43), they permit the exemplary inner cannula (40) to threadably mate with proximal threads (110) of spinal implant (101) (Application at para. [0040] and FIGS. 2 and 6).

Accordingly, Applicants submit that each of claims 1, 9, and 10 recites a combination of elements not disclosed in the prior art of record and the claims should therefore be allowed.

Moreover, as each of claims 2-8 depends from one of allowable independent claims 1, 9, and 10, and further as each of these claims recites a combination of elements not disclosed in the prior art of record, Applicants respectfully submit that these claims should be allowed as well.

Claim 5 has been amended to recite language consistent with amended claim 1, from which it depends. No new subject matter is introduced by way of this amendment.

Claim 11 has been added to the application and introduces no new subject matter. Claim 11 includes a recitation of the threads on the inner cannula being configured to engage an externally threaded portion of the spinal implant. This is fully supported in the specification (Application at FIGS. 2, 3a, and 3b, and para. [0040]). Claim 11 depends from allowable independent claim 1 and is therefore allowable at least for the foregoing reasons discussed with respect to the rejection of claim 1.

Claim 12 has been added to the application and introduces no new subject matter. Claim 12 includes a recitation of the inner cannula including threads integrally formed with the inner cannula. This is fully supported in the specification (Application at FIGS. 2 and 7).

Conclusion

In view of the foregoing response including the amendments and remarks, this application is submitted to be in complete condition for allowance and early notice to this effect is earnestly solicited. If the Examiner believes any matter requires further discussion, the Examiner is respectfully invited to telephone the undersigned attorney so that the matter may be promptly resolved. Applicants do not believe that any fees are

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due in connection with this response other than fees associated with the Request for Continued Examination and a one-month extension to respond to the Final Office Action. However, if such petition is due or any fees are necessary, the Commissioner may consider this to be a request for such and charge any necessary fees to deposit account 23-3000.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

/Keith R. Haupt/

Keith R. Haupt

Reg. No. 37,638

2700 Carew Tower
441 Vine Street
Cincinnati, OH 45202
(513) 241-2324 (voice)
(513) 421-7269 (facsimile)

446658